

**Remarks:**

This application has been reviewed carefully in view of the Office Action mailed October 12, 2006 ("the Office Action"). In the Office Action, claims 2, 4, 6-12 and 15 were rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Miura, U.S. Patent No. 6,322,451, in view of Begis, U.S. Patent No. 6,024,643, and further in view of newly cited Reisman, U.S. Patent No. 6,125,388. Claim 13 was rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Miura in view of Begis, further in view of Reisman, and further in view of Luciano, Jr., U.S. Patent No. 6,050,895. Claims 16-21 were rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Miura in view of Begis, further in view of Reisman, and further in view of Quake III Arena™ video game manual.

The applicant respectfully traverses that the claims are obvious under 103(a). Moreover, the applicant has amended the claims to overcome the rejections. No new matter has been added by these amendments (see, e.g., pg. 24, line 21 to pg. 25, line 12). More specifically, the above-described rejections are addressed as follows:

**I. CITATION OF ART**

The Office Action newly cites the patent to Reisman, U.S. Patent No. 6,125,388. However, the Reisman patent has not been listed on any Notice of References Cited or any Information Disclosure Statement by Applicant. The applicant respectfully requests the Reisman patent be cited in a Notice of References Cited so that it will be properly listed as a Cited Reference on the cover of any resulting patent.

## **II. THERE IS NO SUGGESTION TO COMBINE THE CITED REFERENCES**

The appropriate inquiry is not whether it would have been obvious to substitute an element, or modify the prior art, in a manner advanced by the Examiner, because that is not the appropriate test of patentability. *See, e.g., In regarding Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Rather, to meet its burden of showing prima facie obviousness, the PTO must necessarily show some objective teaching that would lead one of ordinary skill to combine the relevant teachings to solve the problem confronting the applicant. *In regarding Fine, supra.*

Regarding independent claims 7-9 and all dependent claims, all of the above-recited rejections include a recitation to Miura, in view of Begis, and further in view of Reisman. As a motivation to combine, the Office Action (on page 3) recites Begis for the proposition that a real player can play with a virtual proxy player that represents the skill level of a particular real player. It is noteworthy that the purpose of this function in Begis is to verify that the real opponent is of suitable skill level for scheduling a game at a later date. This permits a player to identify good candidates for head-to-head match-ups without having to overcome real life scheduling conflicts for a test match (see, Begis, col. 5: 50-53). The Office Action further recites Begis for the statement that “[t]his system avoids wasting either player’s time when the match is clearly unsuitable.” The applicant notes that this particular statement is not relevant, as it is not made in reference to a real player playing a proxy player, but rather in reference to a system that pits two proxy players against each other (thus not wasting either player’s time) to identify a suitable, live opponent for a given player.

The Office Action (on page 4) recites Reisman for the disclosures that “upon the request from a user for a information objects (updates) the server temporarily disconnects from the user station until completion of the request, and a notification of such completion is sent to the user via the user” and that “such a modification cuts down on congestion and cost of communication lines and reduces the chance of errors of a transmission data.” The Reisman patent is directed to a “System For Transporting Information Objects Between A User Station And Multiple Remote Sources Based Upon User Modifiable

Object Manifest Stored In The User Station.” As clearly stated in Reisman, the Reisman invention “solves the problem of enabling simple, economical and prompt mass distribution of electronic information products” (see, col. 4: 65-67). The recited portions of Reisman should be considered in the context of the Reisman invention.

More specifically, the device disclosed in the portion of Reisman cited in the Office Action (i.e., col. 19: 37-47) functions to provide “simplicity and ease-of-use benefits ... to a user 100 in fetching an information object from a remote server 22 as compared with the use of a conventional communications product” (see, col. 18: 38-43). This simplicity is as compared to a lengthy procedure described from col. 18: 44 - col. 19: 15, and summarized as being “many tedious communication functions such as activating a communications product, specifying a call route, specifying the objects to be transported and deactivating the communications product,” and in addition, “optional pre-transport preparation 104 and execution of store-and-process-fetched-product 106 if these functions are appropriate to the containing information product” (see, col. 19: 16-25).

Based on these above-cited disclosures, the Office Action recites (on page 4) that “[a]s such, one would be motivated to modify Miura to implement a system that matches the best suited opponent to a player, using real or virtual players so that a player’s time is not wasted on an unsuitable match ... and temporarily disconnect the communications line the server and user station until game preparation is complete, as taught by Reisman.”

The applicant respectfully asserts that this conclusion does not logically follow from the discussed disclosures. The proposed combination of Miura system with the Begis system has no reason to suffer any problem for which the Reisman system is identified to be a solution. More particularly, in requesting an opponent, a user of the proposed system would not need to conduct the “many tedious communication functions” that Reisman is designed to alleviate, such as activating a communications product, specifying a call route, specifying the objects to be transported, and deactivating the communications product, as well as pre-transport preparation and execution of store-and-process-fetched-product when appropriate to the containing information product. Moreover, the problem proposed in the Office Action (i.e., a delay of any significance

during game preparation of a game with a virtual player) is neither identified in any of the references nor reasonably inferable.

Indeed, the applicant's own system does not have a need to disconnect players during game preparation. Instead, disconnection is only provided to ostensibly wait for an actual player, and thereby create the illusion that the previously created virtual player is an actual player arriving to play the game. This is clear in the applicant's present claim language, which recites "sending a mail message that preparation for a game is completed after connection between the server and the actual game players is discontinued temporally even if the device for activating selects at least one virtual game players to competitively play, the device for notifying being configured such that the virtual game players appear to the actual game players as actual game players" (emphasis added). Without such a reason to temporarily disconnect from a customer (i.e., without having a system designed to create the illusion of real players), it would be contrary to prevailing business wisdom to disconnect from the customer when a business is prepared to provide them a service.

The inapplicability of Reisman to Miura and Begis is all the more understandable, as Miura and Begis are Game Systems, and Reisman is directed to a "System For Transporting Information Objects Between A User Station And Multiple Remote Sources Based Upon User Modifiable Object Manifest Stored In The User Station."

For the above-noted reasons, there is no suggestion to combine the Reisman patent with the Miura and Begis patents. Therefore, the rejections of claims 2, 4, 6-13 and 15-21 under 35 U.S.C. § 103(a), are now improper, and the applicant respectfully requests they be withdrawn.

### **III. THE CITED REFERENCES FAIL TO DISCLOSE THE ELEMENTS OF THE CLAIMED INVENTION**

In relevant part, claim 7 recites:

a device for notifying the actual game players of the availability of the selected game players to competitively play by sending a mail message that preparation for a game is completed after connection between the

server and the actual game players is discontinued temporally even if the device for activating selects at least one virtual game players to competitively play, the device for notifying being configured such that the virtual game players appear to the actual game players as actual game players.

Independent claims 8 and 9 contain similar recitations, and the dependent claims all incorporate these recitations.

The applicant respectfully traverses that the cited references disclose a device configured such that a virtual game player appears to an actual game player as an actual game player. Moreover, the applicant respectfully traverses that the cited references disclose a device configured for disconnection even if the device selects a virtual game player to competitively play. Furthermore, the applicant respectfully traverses that the cited references disclose these features within a device configured for notifying actual game players of the availability of selected game players to play by sending a mail message that preparation for a game is completed after the connection is discontinued temporally.

Because each of the cited references fails to disclose the above-described features, the rejections of claims 2, 4, 6-13 and 15-21 under 35 U.S.C. § 103(a), are now improper and should be withdrawn. The applicant respectfully requests they be withdrawn.

#### **IV. REQUEST FOR INTERVIEW**

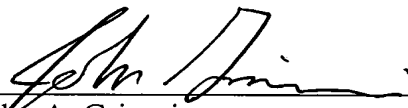
In light of the present amendments and remarks, the applicant believes that the claims are now in condition for allowance. Nevertheless, the present case has received the attention of three different examiners over five years. It is therefore possible that there are open issues of patentability related to resolvable claim construction issues of which the applicant is not fully aware. Such issues might be more readily identified and resolved if the present examiner and the applicant's attorney discuss the claims. Therefore, the applicant requests that before any final action, the examiner contact applicant's attorney for a telephonic interview to try and efficiently resolve any claims that the examiner does not feel are in condition for allowance.

**V. CONCLUSION**

In view of the foregoing, the applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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